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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,113	06/24/2003	Keith G. Weinstock	PATH03-13	3509

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EXAMINER	
ZEMAN, ROBERT A	

ART UNIT	PAPER NUMBER
1645	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/603,113	WEINSTOCK ET AL.	
	Examiner	Art Unit	
	Robert A. Zeman	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2003*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-28* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8 and 11-13, drawn to isolated nucleic acids encoding *Candida albicans* polypeptides, expression vectors comprising said nucleic acids, host cells comprising said expression vectors; methods of producing a polypeptide by culturing said host cells; and vaccines comprising said nucleic acids, classified in class 536, subclass 23.1.

II. Claim 9, drawn to nucleic acid probes, classified in class 536, subclass 24.3.

III. Claim 10, drawn to antisense nucleic acids, classified in class 536, subclass 24.5.

IV. Claims 14-16, drawn to methods of treating *Candida albicans* infection utilizing a nucleic acid encoding a *Candida albicans* polypeptide, classified in class 514, subclass 44.

V. Claims 17-20, drawn to *Candida albicans* polypeptides and vaccines comprising said polypeptides, classified in class 530, subclass 350.

VI. Claims 21-23, drawn to methods of treating *Candida albicans* infection utilizing a *Candida albicans* polypeptide, classified in class 424, subclass 274.1.

VII. Claim 24, drawn to methods of detecting *Candida albicans* nucleic acids, classified in class 435, subclass 6.

VIII. Claim 25, drawn to a computer readable medium containing nucleotide sequences, classified in class 707, subclass 102.

IX. Claim 26, drawn to a computer based system comprising a data storage means; a search means; and a retrieval means, classified in class 707, subclass 102.

X. Claim 27, drawn to a method of identifying commercially important nucleic acid fragments of the *Candida* genome via database comparison, classified in class 702, subclass 20.

XI. Claim 28, drawn to a method of identifying an expression-modulating fragment of the *Candida* genome via database comparison, classified in class 702, subclass 19.

Sequence Election Requirement Applicable to Groups I-VII

In addition, Groups I-VII detailed above each read on a multitude of patentably distinct SEQ ID Numbers. Each sequence is patentably distinct because the sequences are structurally unrelated protein or nucleic acid sequences, and a further restriction is applied to each Group. Applicant must further elect a single SEQ ID NO. (See MPEP 803.04).

Applicant is advised that examination will be restricted to only the elected SEQ ID NO and combination (if applicable) and should not to be construed as a species election.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III, V, VIII and IX are separate and distinct from each other, as they comprise differing physical, biochemical and immunological entities having differing properties and uses.

Inventions IV, VI, VII, X and XI are each separate and distinct from each other as they are drawn to differing methods having different steps, different goals and leading to differing results.

Invention I is related to Inventions IV and VII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the nucleic acids of Invention I can be used in recombinant techniques.

Inventions V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the polypeptides of Invention V can be used to make antibodies

Invention VIII is related to Inventions X and XI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the database of Invention VIII can be used for homology searches.

Invention IV is separate and distinct from Inventions II, III, V, VIII and IX, as the compositions of Inventions II, III, V, VIII and IX cannot be used in the methods of Invention IV.

Invention VI is separate and distinct from Inventions I-III, VIII and IX, as the compositions of Inventions I-III, VIII and IX cannot be used in the methods of Invention VI.

Invention VII is separate and distinct from Inventions II-III, VIII and IX, as the compositions of Inventions II-III, VIII and IX cannot be used in the methods of Invention VII.

Invention X is separate and distinct from Inventions I-III, V and IX, as the compositions of Inventions I-III, V and IX cannot be used in the methods of Invention X.

Invention XI is separate and distinct from Inventions I-III, V and IX, as the compositions of Inventions I-III, V and IX cannot be used in the methods of Invention XI.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

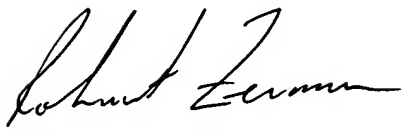
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.
In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**
Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (571) 272-0866. The examiner can normally be reached on Monday- Thursday, 7am -5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ROBERT ZEMAN
PATENT EXAMINER

June 13, 2006